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09/741,994	12/22/2000	Paul Levi Williams JR.	088305/0121	7764

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EXAMINER
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CUFF, MICHAEL A

ART UNIT	PAPER NUMBER
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3627

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/741,994  
Filing Date: December 22, 2000  
Appellant(s): WILLIAMS ET AL.

William T. Ellis and Aaron C. Chatterjee  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11/17/05 appealing from the Office action mailed 3/4/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 10, 13-16, 19, 20, 24, 27, and 28 are rejected under 35

U.S.C. 102(a) as being anticipated by [www.ediconsulting.com](http://www.ediconsulting.com).

Claims 3-9, 11, 12, 17, 18, 21-23, 25, and 26 are rejected under 35 U.S.C.

103(a) as being unpatentable over [www.ediconsulting.com](http://www.ediconsulting.com) in view of Call, Reed, and Bakalash.

#### **(10) Response to Argument**

##### The format of the appeal brief

The examiner appreciates appellant re-submitting the appeal brief with the two new appendixes. This is a matter of office policy, not the choice of the examiner. The current brief does not have the proper headings. For example, section VI should be "Grounds of rejection to be reviewed on appeal" and separate headings are required for each ground of rejection in the "Argument" section. Per MPEP 1205.03, minor non-compliance in an appeal brief, such as a minor error in the title of a section heading, should not require a corrected brief.

The appellant makes two major assertions

1. The prior art does not show the limitation of “automatically determining, by the host server, suitable electronic commerce EDI products or services for said user based at least in part on said requirements information from said selected trading partners;”

and

2. The inherency that the examiner has relied upon for the database does not meet the necessary criteria.

The examiner does not concur.

First assertion:

In order to properly evaluate this limitation, it is very important to look at the specification for how appellant enables “automatically determines”. This is especially true because appellant believes that the prior art teaches away from the claimed invention. The point of this discussion is to determine the degree of automatic appellant actually has. If appellant can stretch its disclosure to use certain language, the examiner believes this same latitude should be given the prior art.

Look at appellant’s “Summary of the Invention”. Starting on line 6 of the summary, the quoted section describes an automated business process, there is no

“automatically determining”. Next, compare the quote in the summary to the cited section in the specification (page 6, lines 20-27). Notice that the section has been misquoted. The phrase “‘knows’ what trading formats and applications are acceptable to the trading partner”. The “knows” is probably the database or the AS400 standard.

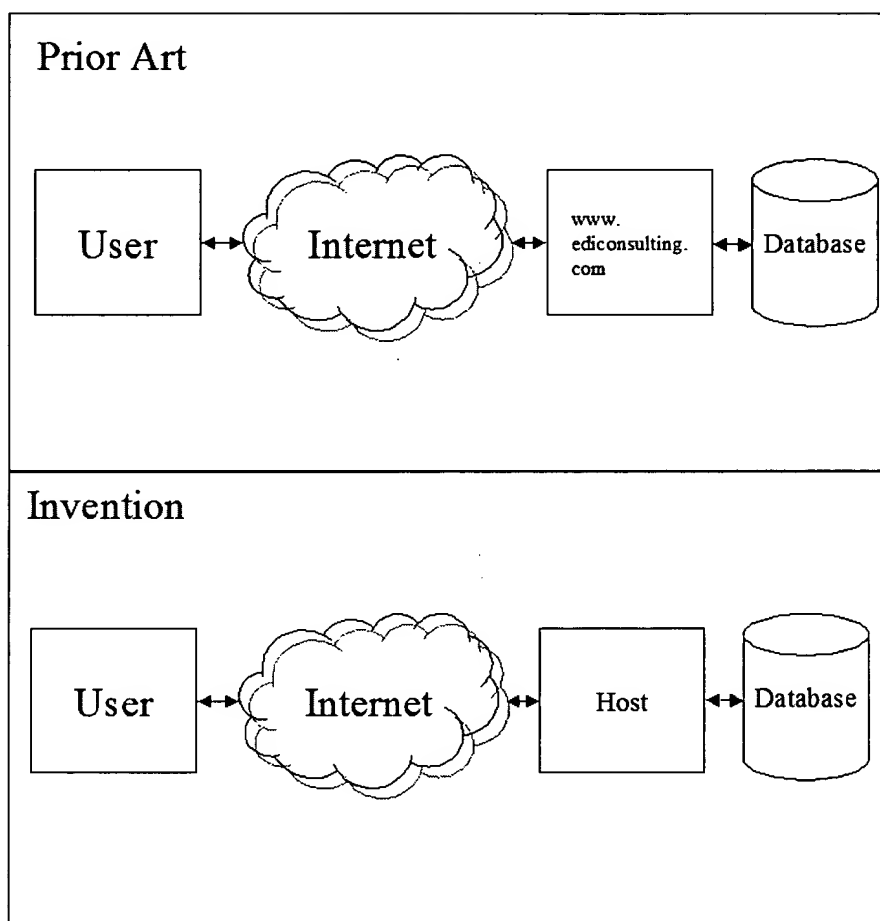
Starting on line 11 of the summary of the invention, appellant cites parts of pages 5 and 10 for support for how the EC/EDI products are determined based on the requirements of those trading partners. The cited portion of page 5 states that the system provides facilities to allow a user to obtain information about EC/EDI products and services. If the system were fully automatic, wouldn't the user just receive information. The cited portion of page 10, lines 9-11, is probably the best description of how the “determining” step is done. The examiner considers this step to a reflection of an automated process, not an automatic process.

On lines 5-17 of the summary of the invention, appellant has nearly quoted the cited sections of pages 11 and 16, but has misleadingly added the word “automatically” into the text, which is not in the original text.

Please keep this analysis in mind when evaluating if the prior art meets the degree of “automatically determining” necessary to read on the claims.

Also, because of some of the cited irregularities shown above, there may be a question if the specification discloses “automatically determining”. The examiner believes that, because some automation is used in querying a database, a 35 USC 112, 1<sup>st</sup> rejection would be improper.

Below is a flow diagram to illustrate how the prior art and the invention are related. It is followed by a claim map of claim 1.



The ediconsulting.com site is providing a host server, which is accessed by the user via the Internet.

The ediconsulting.com site obtains information from said user just like the host must.

The ediconsulting.com site retrieves requirements information from a database relating to predetermined EC/EDI requirements.

The above steps of obtaining and retrieving and the last step of obtaining registration information are supported by the definition of mapping, which was provided by an online technical glossary and has never been challenged. Mapping is the development of a transaction set customized to match the format that two trading partners have agreed to use for exchanging one type of transaction. The ediconsulting.com site provides a mapping service and therefore meets these steps.

The ediconsulting.com site is silent as to precisely how it determines suitable EC/EDI products, but it must use an automated and interactive process using a database of rule and trade partners and the Internet. The examiner believes that this disclosure meets the metes and bounds of applicant's "automatically" determining step.

The ediconsulting.com site must obtain registration information in order to map.

#### Second Assertion:

Appellant asserts that the inherency that the examiner has relied upon for the database does not meet the necessary criteria. The limitation for the database is in claim 2 and the existence of the database supports examiner's position above for meeting the "automatically determining" step. The only criteria for the database are that it must contain EC/EDI requirements information for a plurality of hub trading partners. There are no other guides as to what constitutes this "information".



Mapping is the development of a transaction set customized to match the format that two trading partners have agreed to use for exchanging one type of transaction. It would be fair to say that there was some kind of information about requirements of trading partners necessary to perform this function. The page shows a testing section, which says, "It's likely we have already done EDI with your trading partners. Let our broad industry experience speed up your EDI implementation." In order to make this statement, it would be reasonable to say that the reference had to save some of its past work to facilitate future jobs. The past work had to be an electronic transaction set in order to perform electronic data interchange or EDI, thus meeting the broadly recited database.

Applicant has recited a section from MPEP 2112. The next paragraph after applicant's citation reads:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

Based on the extremely broad limitation and the examiners technical reasoning to reasonably support the determination, the examiner believes that the criterion for inherency has been shown.

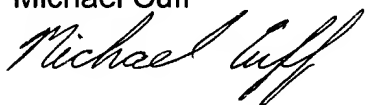
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Cuff



Conferees:

Alexander Kalinowski



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